REMARKS/ARGUMENTS

The Examiner previously rejected claims 1, 3, 4 and withdrew claims 32-40. Applicants have cancelled claims 1-4, and amended claims 32-40 to again be product-by-process claims, therefore in compliance with the most recent restriction requirement. Applicants respectfully request that the Examiner reconsider the patentability of claims 32-40 in view of the remarks below.

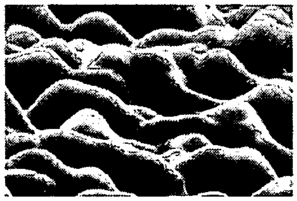
I. Rejections Under 35 U.S.C. § 102

A. The Process Steps Result In Structural Differences

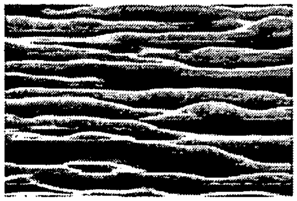
The present invention is directed to producing an invertible, elastomeric master from a master created in a photosensitive medium. The process of making the master has important consequences for the quality of the final product.

1. The Making Of The Master In The Photosensitive Media Defines The Structure To Be Replicated

Steps (1) through (4) in claim 1, for making a master in the photosensitive medium, have consequences for the type of microstructure that is made. The speckle pattern created by steps (1) through (4) are wave-like. The dimensions of the waves in the medium may, in a most general sense, be similar in size in the case of a circular diffuser. However, the waves can be elongated quite a bit in one dimension for an elliptical diffuser.



50° LSD
SEM Structure 1500x



60° x 1° Elliptical LSD
SEM Structure 600x

The random waves have important characteristics that must be precisely replicated to have a high-quality light-shaping diffuser. The first micrograph is of a diffuser made according to steps (1) to (4) of claim 32. The waves of the first micrograph result in a light-shaping diffuser that light in a 50 degree cone. The second micrograph is a micrograph of a diffuser where the light comes out in an ellipse where the angle of the cone is 1 degree on the narrow axis and 60 degrees on the wide axis. Thus, while the method dictates a kind of structure, that kind structure is difficult to claim structurally with precision.

The quality of the light-shaping is dependent on a precise type of randomness of structure. To obtain quality light-shaping means that the shape formed in the mastering process needs to be precisely replicated. If the waves do not have the kind of structure seen in the micrographs, and are duplicated inaccurately, the quality of the diffuser is compromised.

2. Making An Invertible Master Is Important

Each copying of the speckle pattern degrades the quality of the replication of the speckle pattern. While some may have doubted that the strains of inversion would result in a better copy than two transfers, the inventors have found that the use of their invertible master results in a better quality final product. They tried a number of other techniques to copy masters of the type specified in steps (1) through (4) of claim 32.

Because of the random nature of the pattern being replicated, the inversion of the original pattern is just as useful as the original pattern. As long as the replication is precise, inversion of the pattern does not change the quality. However, a degraded copy non-inverted copy is much less useful than a good inverted copy.

The invertible master permits the creation of an outwardly patterned copy of the pattern made in the photosensitive medium instead of two steps. This transformation of the pattern in the photosensitive material, which cannot be easily worked with, into an elastomeric master in one step. The remainder of the patent goes into preferred techniques for producing a metal master.

The prior art simply does not teach making an inverted, outwardly facing speckle pattern copy in a medium suitable for the other steps in this patent. By requiring the extra transfer of the image, the prior art introduces degradation that is difficult to describe structurally.

Accordingly, the product-by-process claim is important for claiming the elastomeric master because:

1) it is a particular way of producing a first-generation copy
2) of a structure that is difficult to describe.

B. The Content of WO 91/1225

WO 91/1225 discloses a method of making the roller comprises the following steps:

1. providing a master roller;
2. placing the master roller inside a sleeve;
3. filling the void between the master roller and the sleeve with *silicone casting rubber*, and then setting and curing the rubber; and
4. removing the master roller .

WO 91/1225 at page 7, lines 1-20.

At this stage, there is an image of the master roller formed interior to the sleeve. Although there is a hollow structure at this stage, the diffuser is formed on the interior of it, not the exterior of it as required by the amended claim.

The process continues:

5. inserting a mandrel into the inner diameter of the casting material;
6. inserting *a heat resistant relatively soft resilient material* into the gap between the casting material and the mandrel;
7. hardening and curing the material to form an externally cast layer on the mandrel;
8. removing the mandrel and the cast layer together

WO 91/1225 at page 7, line 22 to page 8 line 3.

No mention is made of the invertibility of an either of the formed layers.

C. The Differences Between The Claimed Invention and WO 91/1225

1) "applying an effective amount of a liquid curable photosensitive medium,"
2) "curing [a] layer of photosensitive medium,"
3) "subjecting the cured photosensitive medium ... to a source of coherent light," and
4) "developing the exposed photosensitive medium."

In particular, the process of the present invention, which uses the continuous application of coherent light having a preselected speckle to provide seamlessness has no equivalent in WO 91/1225. WO 91/1225 only teaches that such a master can be obtained by "any desired method," and does not enable the process steps cited above. It does not enable seamlessness. If a reference is not enabling, it does not serve as a proper basis for rejection. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1336 (Fed. Cir.

2008) (*citing In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1379 (Fed. Cir. 2007)).

Further, in response to the July 16, 2008 Office Action, WO 91/1225 does not disclose light shaping diffusers. Not all holograms are diffusers. Further, light-shaping in the context of this application is directed to controlling where the light travels -- not having an image imbedded in it. Accordingly, WO 91/1225 does not teach light-shaping diffusers as taught by this application. Applicants are willing to provide a declaration to support this assertion if desired by the examiner.

Last, WO 91/1225 does not disclose creating an embossing machine roller by inverting an object that has an image on its inside to present an image on its outside as claimed. Instead, WO 91/1225 uses two transfers rather than a transfer and an inversion to make its elastomeric master. If the "inner surface 25" was suitable for inversion and use WO 91/1225 does not teach that.

II. Conclusion

It is respectfully submitted that the subject application is in condition for allowance, and a Notice of Allowance is earnestly solicited. Should the Examiner have any questions, or find that conversation with Applicant's attorney would advance the application, please contact the undersigned attorney at the phone number below.

Respectfully submitted,

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By:____________________
Erik B. Flom, Esq.
Registration No. 41,021

HUSCH BLACKWELL SANDERS
WELSH & KATZ
120 South Riverside Plaza
Suite 2200
Chicago, Illinois 60606
Telephone: 312/655-1500
Facsimile: 312/655-1501